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10/583,589

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Daniel Migault

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EXAMINER

NGUYEN, PHUNG HOANG JOSEPH

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/583,589	<b>Applicant(s)</b> MIGAULT ET AL.	
	<b>Examiner</b> PHUNG-HOANG J. NGUYEN	<b>Art Unit</b> 2614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 9-17 is/are rejected.
- 7) ☒ Claim(s) 5, 6 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-4, 7 and 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamczyk (US Pat 7,320,026) in view of Bernman et al (US Pub 2002/0076027).**\

As to claims 1 and 9, Adamczyk teaches a method of sending at least one request (R) (***one or more requests, col. 2, line 2***) to a domain name server (***col. 2, line 3***) from a requesting machine (H) (***label 304 of fig. 3 or label 306***), said domain name server (***col. 2, line 3***) being an E.164.arpa telephone number (***ENUM format, col. 7, line 6 and lines 19-25***) domain name server and each name being determined from an E.164 format destination telephone number (NTEL) (***the destination subscriber, col. 8, line 6***) contained in said request (R) (***the send message request includes a phone number identifying the destination subscriber, i.e., the subscriber that will receive the message, col. 8, lines 5-8***).

While Adamczyk teaches various databases (***Enum database 134 of fig. 1; database systems 318 and 322 of fig. 3***), Adamczyk does not explicitly teach a prior test of the validity of the destination telephone number (NTEL) of the request (R) is

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executed automatically and locally to the requesting machine (H) relative to a telephone number database (BD) local to the requesting machine (H) in order to forward the request (R) from the requesting machine (H) to the domain name server only if its destination telephone number (NTEL) passes said test.

Bernman teaches the telephone number local to the requesting machine and automatically and locally testing the validity of the destination number (*the communications system 40 also includes one or more supervisory systems (SS) 48 and one or more databases (DB) 50. Here examiner maps the requesting machine to the supervisory system. Further note that... databases 50 are shown associated with (situated on/at) the PSTN 14, see fig 3 and [0035]; Furthermore, The determination of the called party's user information can be carried out in a variety of ways. For example, the supervisory system 48 may query its own database 50. Alternatively, the supervisory system 48 may use a similar method to that described above with regard to the first embodiment to query a database 50 of the PSTN and retrieve a voice mail address for the called party. This may then be used to pre-fill the called party's voice mail address in a message compose session at the calling party's supervisory system 48, [0042]*). Examiner's note: Here the process of determination is performed to determine the validity of the called number whether at least one communication address may include using information about the called party in a query to at least one database to obtain other information about the called party [0007];

Furthermore, Bernman teaches the validity of testing and determines that the destination telephone number passes said test (Using the available called party

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addresses that have been determined by one or more queries of one or more databases, the supervisory system 48 presents the available messaging options to allow the calling party to determine the type of message the calling party wishes to compose (S500), [0044])

Therefore it would have been obvious to the ordinary artisan at the time of the invention was made to incorporate the teaching of Bernman into the teaching of Adamczyk for the purpose of complete verification of destination address or destination telephone number. Service can only be provided after the verification process to support the quality of service and privacy. Though in reality, verification of destination telephone number is commonly practiced in the call setup, call connection art. It is better for the ordinary artisan to **explicitly** articulate in seeking protection from infringement.

Claim 2, Adamczyk teaches one prescribed country code (CC) is stored in the local database (BD), and said test includes verifying whether the country code (CC) of the destination telephone number (NTEL) of the request (R) is stored in the local database (ENUM takes a complete, international telephone number and resolves it to a fully qualified domain name address using a Domain Name Service (DNS)-based architecture. With ENUM registration of telephone numbers, many systems such as a subscriber's email, fax, instant messenger, and phone could all be reachable by using the same telephone number (col. 4, lines 56-62; here country code is included in the international telephone number... Furthermore, country code as the form is lay out: 4043322278 is represented as 8.7.2.2.2.3.3.4.0.4.1.e164.arpa. In this particular

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situation, e164.arpa represents the domain name 1 represents the country code (in this case, 1 for the USA) and 404 represents the area code... **(col. 7, lines 20-25).**

country code as the form is lay out: 4043322278 is represented as 8.7.2.2.2.3.3.4.0.4.1.e164.arpa. As appreciated by the ordinary skilled artisan, e164.arpa represents the domain name 1 represents the country code (in this case, 1 for the USA) and 404 represents the area code... **(col. 7, line 6).**

As to claims 3-4 and 7, Adamczyk teaches at least one numbering plan is stored in the local telephone number database (BD) (for example 4043322278 is represented as 8.7.2.2.2.3.3.4.0.4.1.e164.arpa, col. 7, line 24) the numbering plan or each numbering plan comprising at least one block (BN) of telephone numbers **(e164.arpa = domain name; 1 = Country code (CC); 404 = area code or NPA; the last 7 digits (3322278) sometimes known as NPP/NXX).**

It is obvious that the negative result of the test is reported if the test determines that the number being tested does not meet the criteria.

As to claims 10 and 11, Adamczyk does not explicitly teach the device, wherein the receiver means (DR), the telephone number database (BD), the automatic control means (DC), and the sending means (DE) are in the requesting machine (H) *(It is obvious to the ordinary artisan, the requesting machine in this case is a computer 304 or a telephone system 306 or a PDA or a Mobile phone/smart phone... All of these devices (requesting machines) have all of the components mentioned above).*

Furthermore, Bernman also teaches the device, wherein the receiver means (DR), the telephone number database (BD), the automatic control means (DC), and the

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sending means (DE) are in the requesting machine (H) (*The communication device 42 may be a computer, a telephone (conventional or advanced), a mobile phone, a personal digital assistant (PDA), a pager, or the like. As will be described further below, the characteristics and capabilities of a particular communication device 42 will determine the available functionality, [0034]; A computer includes the indicated means).*

As to claim 12, Adamczyk, in view of Bernman, teaches a requesting machine including device for sending at least one request (col. 2, lines 8-9)

As to claim 13, Adamczyk, in view of Bernman, teaches a computer program adapted to be stored on a data medium and including program instructions for executing the method according to claim 1 of sending at least one request (**col. 2, line 63**).

As to claim 14, Adamczyk, in view of Bernman, teaches a system comprising at least one E.164.arp a numbering domain name server and a plurality of requesting machines (H) according to claim 12 adapted to send at least one request to said server(s) (**see claim 1 or 9**).

Claim 15, Adamczyk does not but Bernman teaches the prior test of the validity of the destination telephone number (NTEL) of the request (R) is executed automatically and on the requesting machine (H) (*The communication device 42 may be a computer, a telephone (conventional or advanced), a mobile phone, a personal digital assistant (PDA), a pager, or the like and ... will determine the available functionality. Preferably, the communication device 42 is a computer ...may also be adapted to perform some of*

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*the functions and methods of a supervisory system by computer executable codes stored on a computer readable media such as a floppy disk, [0034]).*

Claim 16, Adamczyk does not but Bernman teaches the telephone number database (BD) is in the requesting machine (H). the databases may also be associated with certain communication devices 42, [0035]).

Claim 17, Adamczyk does not but Bernman teaches the device is in the requesting machine (H) *(the supervisory systems 48 are shown as being associated with (situated on/at) the PSTN 14, however, the supervisory systems 48 could also be associated with (situated on/at) certain communication devices 42, [0035]).*

### **Allowable Subject Matter**

Claims 5-6 and 8 are objected to as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments, with regards to the claims, have been fully considered but they are not persuasive.

Applicant argues that (quoting the key point):

Adamczyk fails to teach "a prior test of the validity of the destination telephone number (NTEL) of the request (R) is executed automatically and locally to the requesting machine (H) relative to a telephone number database (BD) local to the requesting machine (H) in order to forward the request (R) from the requesting machine (H) to the domain name server only if its destination telephone number (NTEL) passes said test" as recited in independent claim 1 and correspondingly recited in independent claim 9. And no combination of Adamczyk and Bernnan teach the subject matter. (Remark, page 8)....



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Examiner respectfully disagrees. Applicant appears to make argument against the references individually, in response to such attempt, the court states that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, in response to applicant's argument that there is no combination of Adamczyk and Bernnan that teach the subject matter, examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

In this case, **examiner has previously admitted that while Adamczyk does not specifically teach local database and validity test**, however, Bernnan teaches what is lacking in Adamczyk. Multiple supervisory systems 48 working closely with the multiple terminals [0035] making the request, querying its own (or local) database and determining called party's telephone number. In one embodiment, retrieve a voice mail address for the called party. This may then be used to pre-fill the called party's voice mail address in a message compose session at the calling party's supervisory system 48, [0042]). The process of determination is performed to determine the validity of the

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called number whether at least one communication address may include using information about the called party in a query to at least one database to obtain other information about the called party [0007];

Examiner recalls that examiner has discussed this determination process with the attorney at the last interview in March. Examiner respectfully reiterates the position that the validity of a call processing test is a function of digit analysis. Every single digit entered, will be run through a database and verify the authenticity of the destination prior to establishment. Examiner also presented at the interview that the process of validity testing from a position of an ordinary skilled knowledge person in the art (while not explicitly presenting by either Adamczyk and Brennan) that the process of validity test is a pre-requisite steps of any communication establishment. Examiner provided example of the VOIP which utilizes the SIP protocol. A requesting party will always send an INVITE message for verification and server/database will only make establishment with there is ACK return. A negative acknowledgement (NOACK) will cease the process. Here the server will test to see the request is an authentic and valid request before granting the connection. Admittedly, both prior artists do not discuss. However, examiner believes that the teaching is falling within the framework “the knowledge generally available to one of ordinary skill in the art” as defined by the court (See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007)).

For the above reasons, examiner respectfully sustains the rejection.

### **CONCLUSION**

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUNG-HOANG J. NGUYEN whose telephone number is (571)270-1949. The examiner can normally be reached on Monday to Thursday, 8:30AM - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571 272 7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CURTIS KUNTZ/  
Supervisory Patent Examiner, Art Unit 2614

/Phung-Hoang J Nguyen/  
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